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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,928	12/14/2004	Peter Eichhorst	EICHHORST - 1 PCT	6882
25889	7590	09/25/2007		
WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			EXAMINER VU, QUYNH-NHU HOANG	
			ART UNIT 3763	PAPER NUMBER
			MAIL DATE 09/25/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/517,928

Applicant(s)

EICHHORST, PETER

Examiner

Quynh-Nhu H. Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/14/04 & 05/18/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. According to Figs. 1-5, a channel 8 is belonging to pre-injection device part. However, Applicant recites that the main injection device has a channel 8 (in claim 7). This does not match with Figs 1-5.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear that applicant recites that chamber and channel are denotes same number 8.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1- 16, 19-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Neracher (WO 02/49697).

Neracher discloses, in Figs. 1-2, an injection device for needle-free injection of a medium into the tissue of a human or an animal wherein a needle-free pre-injection device 3, and a main injection device.

Regarding claim 2, the pre-injection device has a first chamber 2 and the main injection device has a second chamber 7; a nozzle 20 intended to be set onto the skin is connected with the chamber 2 of the pre-injection device and with the outlet of the main injection device by way of a kick-back valve 14, 15; and a pressure-production device 206 that is connected with the chamber 2 of the pre-injection device is configured to produce a high-pressure jet from the nozzle 20 that penetrates the tissue, whereby the chamber 2 of the pre-injection device has a volume sized exclusively for producing an injection channel in the tissue, and the chamber 7 of the main injection device has a volume intended for the medium to be injected.

Regarding claim 3, the chamber 7 of the main injection device has a piston 9 that can be moved by hand.

Regarding claim 5, the pre-injection device has a coupling device 237 for a connection with a main injection device that contains the medium to be injected.

Regarding claim 6, the pressure-producing device 206 or the pre-injection device has a pressure plate 234 or 239 biased by a spring force 238.

Regarding claim 7, a channel 205 connected with the nozzle 20 of the pre-injection device.

Regarding claim 8, a valve 14 or 15 is disposed within the channel (see Fig. 1a below).

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Regarding claims 9-10, a trigger 16 holds a pressure plate biased by a spring (see Fig. 1a below); or a trigger 239 holds a pressure plate 234 biased by a spring 238 (see Fig. 2b below); and a trigger is connected with the chamber 2.

Regarding claim 11, a membrane (a distal part of 210) is part of the piston 210 connected with chamber 2, and this membrane activates the trigger by way of a pusher 235.

Regarding claim 12, the channel 4 has a connection with the chamber 13, and the valve 14 or 15 is disposed between the connection and the coupling device (Fig. 1a)

Regarding claim 13, the chamber 4 has a piston 9 or 10 that rests against the pressure plate (Fig. 1a).

Regarding claim 14, the main injection device and pre-injection device have a common nozzle 20.

Regarding claim 15, a trigger 16 or 239 of the pre-injection device indirectly activated by the pressure produced by the main injection device.

Regarding claim 16, the pre-injection device and the main injection device have a common chamber 4 or 204 for accommodating the medium to be injected; a common pressure-production device 5 or 206 Regarding claim 17, the common pressure production device 5 or 206 has a single spring (located at the valve 14, 15 of Fig. 1a) or 238, 245 of Fig. 2a; the common pressure production device has a means for reducing the size of a first, slight part of chamber in a first step, by a small volume, at a great pressure, and in a second step, by a great volume, at a low pressure (see page 14, line 14- page 15, line 7).

Regarding claims 19-20, the pre-injection medium is a physiologically non-problematic liquid.

Regarding claims 21-24, they encompass the same scope of the invention as to that of claims above except they are drafted in method format instead of apparatus format. The

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claim(s) are therefore rejected for the same reason as set forth above. Also, see page 14, line 14-page 15, line 7 for more details)

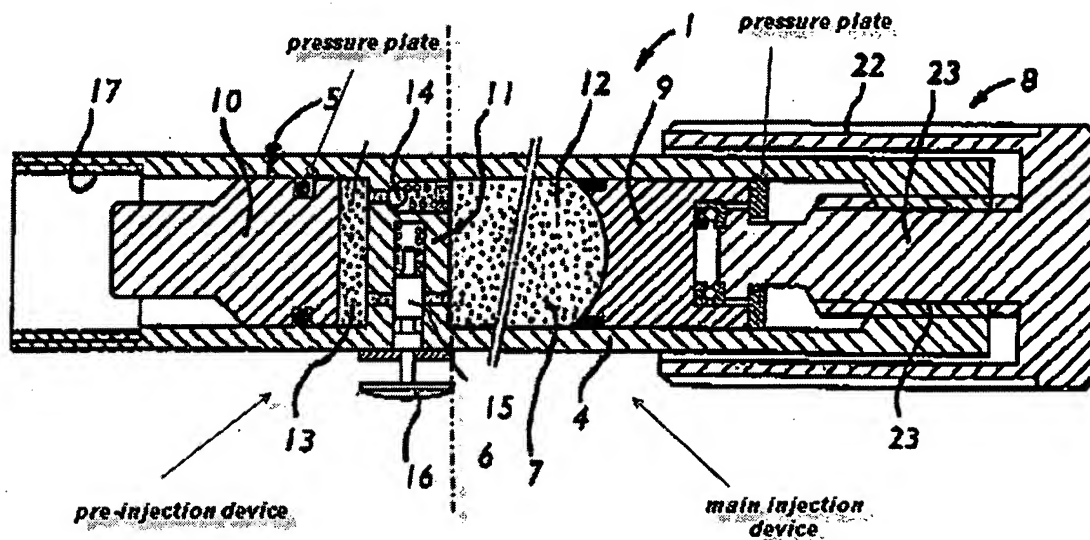
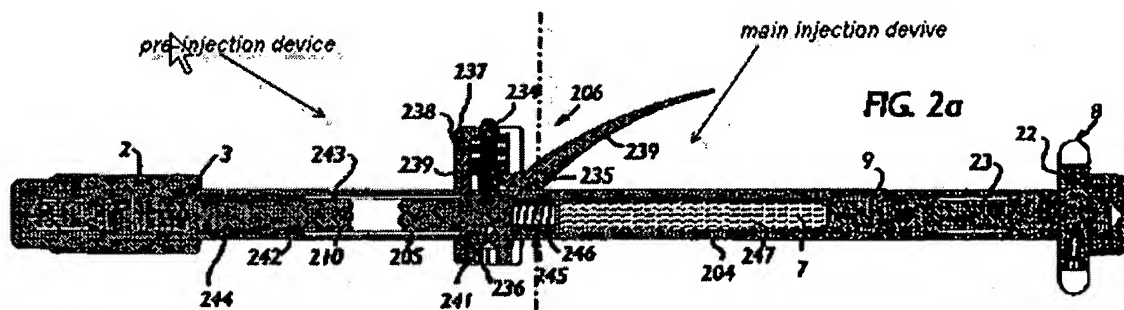


Fig. 1a



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Claims 1 and 13-14, 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Dixon (US 4,722,728).

Regarding claims 1, 13-14, Dixon discloses a device for needle-free injection comprising a needle-free pre-injection device (part A), and a main injection device (part B) having a chamber B; wherein the chamber B has a piston 47 that rest against the pressure plate 21 and can be displaced in length, and a channel 44 is guided through the piston 47 and the pressure plate 21. The device has a common nozzle.

Regarding claims 17-18, Dixon discloses a damping means 18; a common pressure production device has springs 23 and 17 (Figs. 1-2) having different spring stiffness values and spring paths, whereby a first spring element 23 for moving the piston has a high spring stiffness and a short spring path, a second spring 17 has a low spring stiffness and a long spring path.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quynh-Nhu H. Vu whose telephone number is 571-272-3228. The examiner can normally be reached on 6:00 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

QNV


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